

REMARKS

In the Official Action, the Examiner set forth a single rejection of all of the claims (i.e., claims 1-5, 7-10 and 27) under 35 U.S.C. § 103(a) over the combination of Lam, U.S. Patent No. 3,615,480, and newly cited Suzuki et al., U.S. Patent No. 5,532,116. The Examiner conceded that Lam does not specify the claimed nonionic aromatic ether surfactant, but relied on Suzuki et al. to show the claimed surfactant.

Applicants respectfully submit that the proposed combination of patents is improperly based on applicants' own specification and, even if a proper basis for combining the patents exists, the combination would still not result in the present invention or lead to a recognition of the advantages which can be obtained therefrom. In particular, Lam discloses an aqueous developer comprising an alkali metal silicate having a silica to alkali metal oxide ratio greater than 1.5 and one or more water-miscible organic solvents having a pH of 10.0 to 13.0 and capable of removing all the unexposed areas of a photopolymerizable layer containing an ethylenically unsaturated monomer. There is no requirement of a surfactant, much less a requirement of a nonionic aromatic ether surfactant, but surfactants are generally mentioned at column 6, lines 16-18. Triton X-100 is used in the developer set forth at the top of column 5 and the chemical name for this material is recited in dependent claim 6.

As noted above, the Examiner has conceded that Lam does not specify the claimed nonionic aromatic ether surfactant, but has relied on Suzuki et al. to show the claimed surfactant. Suzuki et al. discloses an aqueous alkaline developing solution containing a combination of the anionic surface active agent having the

defined formula (II) or the defined formula (III) (which are both alkylnaphthalene sulfonate salts) and a nonionic surface active agent having a polyoxyethylene moiety and an aromatic ring in its structure which is preferably polyoxyethylene alkylphenyl ether (i.e., having an alkylbenzene ring) or polyoxyethylene naphthyl ether (i.e., having a naphthalene ring), and more preferably polyoxyethylene naphthyl ether. The developing solution is said to shorten the developing time of a light-sensitive image forming material and prevent an image formed on the light-sensitive image forming material (on a support or a peel layer) from the occurrence of fog and is further said to exhibit excellent developing characteristics if the developing solution freezes, is thawed and then is used. Of the surfactants used in the examples of Suzuki et al., surfactant (C-1) is a polyoxyethylene alkylphenyl ether illustrated at column 20, lines 47-51 and surfactant (c-2) is a polyoxyethylene naphthyl ether illustrated at the bottom of column 20 which has a total of 4 ethoxy units.

The developing solutions of Lam and Suzuki et al. are substantially different so that those of ordinary skill in the art would not be led to combine the respective teachings. The developing solution of Lam requires an alkali metal silicate and a defined silica to alkali metal oxide ratio. In contrast, the developing solution of Suzuki et al. does not require an alkali metal silicate and none of the exemplified developing solutions of the patent describes the presence of any alkali metal silicate. Conversely, the developing solution of Suzuki et al. requires an anionic surface active agent having the defined formula (II) or the defined formula (III) which are alkylnaphthalene sulfonate salts which are not present in the developing solutions of

Lam. Furthermore, the developing solution of Lam does not require a surfactant and certainly not a specific type of surfactant.

With a full appreciation of the distinct nature of the respective developing solutions, those of ordinary skill in the art would not attempt to apply the teachings relating to the developing solution of Suzuki et al. to that of Lam. Even if there was some proper basis for combining the respective patents, it still would not lead to the present invention (and applicants again remind the Examiner that it is improper to rely on applicants' own specification for the required motivation). As explained above, Suzuki et al. describes the importance of the defined anionic surface active agent having the defined formula (II) or the defined formula (III) which are alkylnaphthalene sulfonate salts. Therefore, if one were going to try to combine the teachings of the respective patents (and applicants also note that "obvious to try" is not the standard under §103), one would first be led to using the defined alkylnaphthalene sulfonate salts.

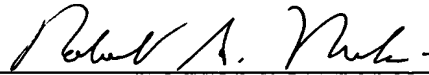
Further extending the assumption that a proper basis exists for using the naphthalene type nonionic surface active agent of Suzuki et al. in the developing solution of Lam, one would be led to the specific material used in the Examples and illustrated at the bottom of column 20. However, this material does not meet the recitation in claim 8 which has been amended consistent with the disclosure on page 34, lines 15-17 to recite a repeating polyoxyethylene chain of 5 to 30 units (with an attendant revision being made in claim 27). Such types of nonionic surfactant are included among those illustrated on page 31 (and include the originally elected species Y-1) and can provided the advantageous results set forth in the specification

as shown in Tables 5 and 6 on pages 70-71. Accordingly, even if a proper basis exists for combining the patents (which applicants again do not concede), the claims of record are patentable and applicants therefore respectfully request reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL PC
(INCLUDING ATTORNEYS FROM BURNS, DOANE, SWECKER & MATHIS)

By: 
Robert G. Mukai
Registration No. 28,531

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-662

Date: November 21, 2005